REMARKS

Claims 108-116, 124, 125, 151-154, 157, and 176-182 were pending and presented for examination and in this application. In an Office Action dated September 4, 2009, claims 108-116, 124, 125, 151-154, 157, and 176-182 were rejected. Claims 108, 124, 151, 154, and 176 have been amended herein. In view of the Amendments herein and the Remarks that follow, reconsideration of all outstanding objections and rejections, and withdrawal of them, is now requested.

Consideration Re-Requested for Information Disclosure Statement

On page 3 of the Office Action, it has been alleged that certain references from previously submitted Information Disclosure Statements (IDSs) could not be located. With respect to reference C12, this reference was previously submitted in IDS filed 2/13/2006 and considered on 9/18/2006. An electronic copy is available on PAIR. With respect to references C49, C104, C111 (box 1); C171 (box 2); C199, C244-C249, C251, C291-C294; C298, C317 (box 3); and C327-C336, C342, C343, C412, C427, C432 (box 4), these references were submitted in hard copy with the IDS filed 6/15/2009 and electronic copies are readily available on PAIR. A copy of the IDS as filed on 2/13/ 2006 and 6/15/09 is submitted herewith. With respect to reference C158, it was not considered because it was alleged that the CD was not provided in ASCII format. However, there are a number of files on the CD in ASCII (text) format.

With respect to references C427-C431, the Office Action indicates that numerous articles concerning HTTP were not identified as being associated with a particular citation and allegedly it could not be ascertained which references belonged to which citation. These references are once again submitted in an IDS filed with this

Amendment and Response. The IDS as now filed provides a separate citation. It is noted that copies of these references are not being submitted as these are already available to the Office on PAIR.

In addition, this application is continuation of a parent patent, U.S. Patent No. 5,960,411, which is now in reexamination under U.S. Serial No. 90/007,946. The IDS filed herewith includes additional references from the reexamination.

Consideration of the references as noted above and in the IDS is requested.

Statutory Subject Matter Under 35 U.S.C. §101 is Claimed

Claims 108-116, 124, 125, 151 – 154, 157, and 176 – 182 are rejected under 35 USC §101, as allegedly being based on non-statutory subject matter. This rejection is now respectfully traversed.

As amended, claim 108 recites:

> A computer-implemented method for ordering an item, the method comprising:
>
> receiving, from a server system, <u>by a computer of a client system</u> a client identifier of the client system;
>
> . . . . (emphasis added).

Claim 176 recites:

> A computer-implemented method for ordering an item, the method comprising:
>
> providing to <u>a computer of</u> a client system a client identifier for the client system, the client identifier being associated with account information of a user;
>
> . . . . (emphasis added)

As now presented (in part above), both of these independent claims recite a step performed by a computer, which corresponds to a particular statutory class, and thus,

patentable subject matter. Therefore, reconsideration and withdrawal of the rejection of these claims and their dependencies is now requested.

In addition, independent claim 151 has been amended to no longer reference a component, but rather a processor configured as set forth within the claim. Hence, it too now recites a particular statutory class, and thus, recites patentable subject matter. Therefore, reconsideration and withdrawal of the rejection of this claim and its dependencies is now requested

Further Limitation Provided Per 35 U.S.C. § 112, Paragraph 4

On page 5 and 6 of the Office Action, claims 124, 125, and 157 were rejected under 35 U.S.C. § 112, ¶4 as allegedly failing to comply with further limiting the subject matter of the previous claim(s). In view of the amendments herein, this rejection is now traversed.

Claim 124 has been amended to recite further steps of the claimed invention of claim 108. In particular, claim 124 now recites method of claim 108 "further comprising providing for display an indication . . . ." As set forth by the statute, the claimed feature recites a reference to the claim previously set forth (claim 108) and then specifies a further limitation of the subject matter claimed (additional step of "providing for display . . . ."). Therefore, the basis of the rejection of claim 124 and its dependent claim, claim 125, has now been obviated. Reconsideration and withdrawal of the basis for the rejection of these claims is requested.

Turning to claim 151, it now recites that the processor of the computer system in claim 108 is "further configured for providing for display an indication . . . ." As set forth by the statute the claimed feature recites a reference to the claim previously set

forth (claim 151) and then specifies a further limitation of the subject matter claimed

("the processor . . . is further configured for providing for display an indication . . . .).

Therefore, the basis of the rejection of claim 157 has now been obviated.

Reconsideration and withdrawal of the basis for the rejection of this claim is requested.

<u>**35 U.S.C. § 112, Paragraph 2 Rejection Obviated**</u>

On page 6 of the Office Action, claims 151-154 and 157 were rejected under 35

U.S.C. § 112, ¶2 as allegedly not specifically pointing out and distinctly claiming the

subject matter regarded as the invention. In particular, the term "component" was

noted. This term has now been removed from the claims. Hence, the basis for the

rejection of claims 151-154 and 157 is now obviated. Therefore, reconsideration and

withdrawal of the basis of the rejection is requested.

<u>**Claims Are Properly Enabled**</u>

On pages 6 and 7 of the Office Action, claims 108 – 116, 124, 125, 151 – 154,

157, and 176 – 182 were rejected under 35 U.S.C. §112, ¶ 1 as allegedly lacking

enablement. This rejection now is respectfully traversed.

Claims 108 and 151 have been amended to now include explicit recitation of

sending the updated account information and the client identifier to the server system.

Using representative claim 108, one skilled in the art would first understand that the

claim recites a method in a particular context. For example, one part of the method is

configured to recite a single action for placing an order. Another part of the method is

configured to correspond with updating account information. Each of these steps is in

the context of receiving a client identifier at a computer of the client system,

persistently storing that client identifier, and sending that client identifier to a server system with the single action order or updated information.

In the context as noted, the claims properly recite that for an item to be ordered the method provides for display "information identifying the item and an indication of a single action that is to be performed to order the identified item." Thereafter, "in response to the single action being performed" the method sends "to the server system a request to order the identified item along with the client identifier without requiring a user to log in to the server system." The claim recites that the request to order is "an order indicated by the single action and the client identifier identifying account information previously supplied by the user of the client system." Thus, unlike the cited prior art that requires at least two steps to place an order, the claimed method recites a single action to place order.

The claim also recites as a part of the process that if there is "a request to change account information" the method receives "log in credentials of the user" and "updated account information" and sends "the updated account information and the client identifier to the server system." This part of the claimed process recites when log in is to occur and is separate from the single action aspect of placing an order.

One skilled in the art would clearly understand the context of the steps of the claims as noted above and find the claims enabled accordingly. Therefore, reconsideration and withdrawal of the basis of the rejection is requested.

A *Prima Facie* Case Has Not Been Established

Claims 108-113, 117, 151-155, 176-180, and 183 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of U.S. Patent No. 5,963,915

("Kirsch") in view of Levy or U.S. Patent No. 5,819,034 ("Joseph"). Claims 124, 125, and 157 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of Kirsch, Levy or Joseph, Gulack or U.S. Patent No. 6,539,548 ("Hendricks"). Claims 114 – 116, 181, and 182 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of Kirsch, Levy or Joseph and further in view of Official Notice. These rejections are respectfully traversed.

The Combination of Kirsch and Joseph Does Not Disclose What is Claimed

Several aspects of the claimed invention are not disclosed or suggested by the cited references considered alone or in the combination proposed by the Examiner. First, Kirsch does not disclose or suggest the claimed feature of "for an item to be ordered: providing for display…an indication of a single action that is to be performed to order the identified item." The citation referenced in the Office Action (Kirsch, col. 8, l. 64 – col. 9, l. 4) does not provide any disclosure of the feature as claimed. Rather, the cited portion takes out of context what is occurring in Kirsch with respect to a transaction.

Reading Kirsch in proper context, it discloses at least two actions to be performed to order an identified item. Kirsch in FIG. 2 and the corresponding description, which corresponds to the portions cited, provides "a number of different scenarios [] where the present invention is utilized in simple to complex purchase transactions . . . ." (Kirsch, col. 7, ll. 20-22; FIG. 2). From there, Kirsch goes on to describe a process requiring at least two actions to order an identified item. Specifically, Kirsch discloses "serving a web page 24 [that has] embedded any number of hyperlinks 26, 28, 30, 32." Kirsch further discloses that the "hyperlink 26 may

represent a direct reference to an embedded URL or an active image map that can be utilized to ultimately resolve a client user selection on a discrete portion of a displayed graphic to a specific URL." (Kirsch, col. 7, ll. 29-33). Kirsch then discloses that the "different but related URLS preferably allow the client user to separately request further information about the indicated product or service, information regarding other related products and services, information regarding the availability, method of shipment and terms of purchase for the indicated product or service, and to directly issue a request to purchase the product or service." (Kirsch, col. 7, ll. 36-42). Hence, this first action request further information about the product or service.

Thereafter, to order the product or service at least a second action must be performed. Specifically, Kirsch discloses "the purchase of the product or service identified by the selected URL 26 can be presented to the client user for approval using a purchase confirmation form identifying the selected product or service, the billing and shipping related information, and provide active confirm and cancel buttons." (Kirsch, col. 8, ll. 27-32). That is, the user must perform a second action for approval of the purchase confirmation.

Other portions for Kirsch provide further details on requiring at least two actions. Kirsch explicitly describes an ordering method that requires two specific actions: [1] "providing for a purchase transaction that appears to the client user as a singular selection of a purchasable product or service <u>and</u> [2] a singular confirmation of the purchase." (Kirsch, col. 4, ll. 48-51 (emphasis added)). Moreover, construing Kirsch in the context of requiring at least two actions is further supported by additional disclosure in Kirsch. For example, Kirsch discloses "allowing a product or service to

be purchased with no more than two <u>required</u> mouse clicks…" (Kirsch, col. 15, ll. 16-19 (emphasis added)). Hence, Kirsch's explicit disclosure of requiring performance of at least two specific actions cannot be read upon the claimed features as set forth in independent claims 108, 151, and 176, which recite performing a single action to order an identified item.

In an attempt to address the deficiency of Kirsch, which requires performance of at least two actions, the Office Action re-introduces the Joseph reference. The Joseph reference was previously disposed of in prosecution as it did not show the claimed feature of a single action. However, nothing has changed warranting reintroduction of this reference for this claimed feature.

As noted in a previous response there was no connection established between pressing a TV remote control button to place an order and what the claimed invention as a whole recited with respect to the single action feature. As was previously established, and not refuted with respect to this reference, web pages on the Internet typically used hyperlinks to impose executable actions rather than displaying an indication of which buttons to press for an action. The assumption that a button corresponds to a single action continues to lack support now: it simply does not follow that it was well known in the art to display an indication of a single action that is to be performed to order the identified item as is claimed.

Further, as noted then and once again here, Joseph had numerous other issues that ultimately showed its deficiencies as a reference. For example, the information that the client of Joseph receives is not stored "persistently" at the client as required by the claims. (See Amendment and Response, June 2, 2008). Permanent storage at the

client in Joseph is in the context of client-entered information (*see, e.g.*, col. 8, ll. 52-57). This entered information is not received from the server as is claimed. Further, Joseph provides no disclosure or support of transmitting the information from the client to the server. Hence, the claims continue to be distinguishable over Joseph.

Moreover, the combination of Kirsch and Joseph fails to disclose the claimed configuration. At best, even assuming *arguendo* that the references were combinable, such combination discloses establishing a secured internet connection through which the two or more actions for a transaction (Kirsch) can be completed through a remote control selection button (Joseph). This is not what is claimed.

The Combination of Kirsch and Levy Does Not Disclose What is Claimed

Described above were deficiencies of Kirsch (as well as Joseph) related to ordering of an identified item through performance of a single action. Kirsch, however has additional deficiencies. Kirsch also does not disclose or suggest "responsive to a request to change account information: receiving log in credentials of the user." The citation referenced by the Office Action makes no reference to this claimed feature or the subsequent claimed feature of "receiving updated account information." The citation referenced (Kirsch, col. 14, ll. 60-65), is best understood in full proper context rather than select piecemeal portions:

> Where a purchase acceptance 94 has been provided by the client user through the confirmation form, an optional PIN for the identified client user may be checked and verified against the client record maintained by the server system. If a PIN is required by a specific server for all purchases, in order to provide a greater degree of authentication by the server, but is either invalid or incorrect, the a modified confirmation form 100 may be provided 92 to the client system indicating the need for a valid PIN in order to confirm the client user's order. If the basic acceptance of an order does not require a PIN or a valid PIN was

entered, the ship-to address presented by the confirmation form is checked to verify that the address corresponds to the client user's credit card billing address, which is presented preferably as the default ship-to address. Where there is no change 102 to the ship-to address, the purchase request is recorded 106. If the address is changed, a PIN is preferably required to additionally authenticate the client user. Again, the modified confirmation form 100 is preferably sent if a PIN was not provided or was found to be invalid. When a valid PIN is received with the confirmation form, the purchase and alternate ship-to address are again recorded 106.

(Kirsch, col. 14, ll. 44-65).

In the proper context as provided, Kirsch merely discloses an additional verification step after a purchase acceptance has been given by the client user. This verification step utilizes a PIN maintained by the server to be matched against the client record in order to provide a greater degree of authentication. (*See* Kirsch, col. 14, ll. 44-53). However, this is not "receiving log in credentials of the user" because Kirsch discloses a PIN that is <u>separate from</u> the login and password used to log into the server system. (*See* Kirsch, col. 6, ll. 30-34). Further, this separate PIN verification is optional and used if a specific server requires a PIN for all purchases, and that an order is not processed without a valid PIN. *See* Kirsch, col. 14, ll. 47-53. Thus, Kirsch does not disclose "responsive to a request to change account information: receiving log in credentials of the user" or "receiving updated account information" in a manner as is claimed.

While it is clear Kirsch is deficient, it is understood that Kirsch was cited as a 35 U.S.C. §103(a) reference. The Office Action cites Levy for correcting deficiencies in Kirsch such as not requiring a confirmation page for an order or that action is needed on a confirmation page (*see* Office Action, page 9). However, the claims do not recite such limitation and for that reason alone Levy too is deficient as a reference.

Nevertheless, assuming *arguendo*, the relevancy of Levy as is alleged, it still does not remedy the deficiencies of Kirsch. With respect to the claimed single action feature, for which Levy is referenced, the Office Action admits that Kirsch "does not explicitly teach that there is one step ordering and a confirmation page is not sent to the buyer." (Office Action, p. 9). This is understood to mean that Kirsch does not teach that an order is "in response to the single action being performed" and "an order indicated by the single action." The Office Action quotes the first paragraph of Levy, and concludes that Levy discloses an order that "consummates…without a confirmation page." (Office Action, p. 9). This is incorrect.

Levy is an article in Newsweek magazine that refers to a system of electronic payment ("e-money" or "e-cash") developed by a company called DigiCash. However, Levy does not provide much technical detail as to how the system works, and thus the quoted portion of Levy has been read out of context. A previously cited reference by Applicant (in the prior Amendment and Response and IDS) provides clarification of the e-cash concept and how it actually works (*See* "Becoming a DigiCash Merchant," Magedlena Yesil, Creating the Virtual Store, p. 289-301 ("Yesil"), IDS filed 2/13/2006). In the e-cash concept, e-cash is withdrawn from a bank and stored on a customer's local computer hard drive. (*See* Yesil, p. 290). "While E-cash is running, a small window is displayed that shows [] the amount of E-cash available to spend." (Yesil, p. 290). This portion explains that the "ledger" ($100.00) in the corner of the screen mentioned in Levy is an amount available to spend, which amount is stored on a local computer hard drive. (*See* Office Action, p. 9).

At the time of a purchase, the user clicks yes to accept a merchant's payment request (p. 291, FIG. D.3), and her system transmits "digital coins" (Yesil, p. 295) from the customer's hard drive to the merchant, who sends them to a bank for acceptance. (*See* Yesil, p. 296, FIG. D.11). This portion explains how a purchase is made, and what occurs as a result of the customer clicking yes, namely, exchange of digital coins using public-key encryption (leading to the ledger reading $95). (*See* Yesil, p. 289, 298; see Office Action, p. 9).

The disclosure in Yesil, which provides the particulars of how the e-cash system operates, clearly illustrates that Levy does not disclose or suggest "in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier …, the request to order being an order indicated by the single action and the client identifier identifying account information previously supplied by the user of the client system." Rather, Levy shows verification of a payment request (FIG. D. 3) for an item after a request to buy something (p. 291 "Bob may send a payment request to Alice, who has asked to buy something"), which results in transfer of digital coins to the merchant. Thus, Levy also does not show that an order is "in response to the single action being performed" and that the order is "an order indicated by the single action." Moreover, a customer clicking "yes" on the payment request, does not trigger transmitting a "request to order" and a "client identifier" to a server system in a manner as is claimed. Thus, as clarified by Yesil, the system of Levy does not remedy the deficiencies of Kirsch.

Moreover, even assuming *arguendo* that Levy showed an order indicated by a single action, it would need to be modified to operate in a system such as Kirsch to

send a request to order and a client identifier instead of digital coins. Similarly, to modify Kirsch to order as a result of a single action, if Levy is assumed *arguendo* to show such ordering, it would require that Kirsch's "simple two phase operation" and "two required mouse clicks" be one action. That is, the suggested combination thus would take the cited aspects of the references well beyond their "established functions," precluding the "predictability" of such combining under *KSR*. Thus, even assuming *arguendo* that the references stood for what the Office Action alleges, the discussion above indicates that the claimed invention is "more than a predictable use of [these] prior art elements according to their established functions." *See KSR*, 550 U.S. 398 (2007). Hence, the combination fails under 35 U.S.C. §103(a).

Therefore, in view of arguments set forth above, a *prima facie* case of obviousness has not been made for claims 108, 151, and 176. These claims are patentably distinguishable over Kirsch and Levy, both alone and in the suggested combination. Further, claims 109-116, 124-125, 152-154, 157, and 177-182, variously depend from claims 108, 151, and 176, which were shown above to be patentable over the cited references and which recite additional features not shown in the cited references. Thus, the arguments noted above are incorporated by reference and applied such that claims 109-116, 124-125, 152-154, 157, and 177-182 also are patentably distinguishable over the cited references.

Additional References Do Not Rectify Deficiencies

In addition, Gulak and Hendricks do not resolve the deficiencies of Kirsch, Joseph, and Levy. These additional references were cited with respect to claims 124, 125 (dependent ultimately on claim 108) and claim 157 (dependent on claim 151),

which have been amended herein. The claims are been amended to recite particular distinguishing features, thus obviating the basis for applying Gulak. As for Hendricks, it provides no additional basis of correcting the deficiencies of the other references. Therefore, the basis of the rejection to claims 124, 125, and 157 should be reconsidered and withdrawn for these additional reasons.

<div align="center">**Official Notice Improper**</div>

Claims 114-116 and 181-182 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kirsch in view of Levy and further in view of Official Notice. As indicated above, claim 114-116 and 181-182 are patentable over the cited references. The alleged Official Notice does not remedy the above-stated deficiencies of Kirsch and Levy, nor does the Office Action allege that it does.

Representative claim 114 recites "displaying includes displaying partial information supplied by the server system as to an identity of the user of the client system." A request was made for documentary support for the assertion that "displaying partial information to protect the user's personal information was old and well known in the art at the time of the invention." In response, the Office Action cites to "Mitchell." As previously noted, Mitchell is a 1997 article about credit reporting agency Experian sending credit reports to the wrong people. From the article: the "report includes partial credit card numbers and other personal information designed to allow customers to identify their own reports. That would make it difficult for others to use the information illegally." The reference provides personal information for credit reporting. However, each of the claimed aspects relate to claimed features that include display of partial information in conjunction with an order for an item.

Further, additional references are noted, but subsequently not applied. If such references are thought to be applicable, it is requested that the claims be appropriately examined in view of such references. Nevertheless, if this Official Notice continues to be maintained, no admission of any of the officially noticed facts is made and the right to argue further against these assertions at a later time, if necessary, is reserved.

Conclusion

In sum, claims 108-113, 117, 151-155, 176-180, and 183, as presented herein, are patentably distinguishable over the cited references (including references cited, but not applied). Therefore, a request for reconsideration of the basis for the rejections to these claims and allowance of them is now made.

Respectfully Submitted,

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